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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,468	02/12/2002	James F. McGuckin JR.	1908	8951

7590

03/30/2004

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EXAMINER

THISSELL, JEREMY

ART UNIT	PAPER NUMBER
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3763

8

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,468

Applicant(s)

MCGUCKIN ET AL.

Examiner

Jeremy T. Thissell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 24 and 25 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-16 and 19 is/are allowed.
- 6) ☒ Claim(s) 1-10, 17, 18, 20-23 and 27 is/are rejected.
- 7) ☐ Claim(s) 28-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 27 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by McGuckin et al (US 6,425,887).

Note that, as discussed in the interview summary of 25 September 2003, McGuckin teaches a retention member as claimed in col. 11, line 26, which discusses a ratchet mechanism.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin in view of Behl (US 5,275,611).

McGuckin teaches all the claimed subject matter except for the tracks/projection. Behl teaches the well-known mechanism of having slide tracks to guide coaxial tubes in their longitudinal sliding relative to one another. It would have been obvious to one of ordinary skill in the art to incorporate such tracks on McGuckin in order to maintain proper rotational alignment and facilitate deployment of the tines. It would have been further obvious to provide more than one of those tracks, since duplication of parts is within the level of skill in the art.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin in view of Imran (US 5,507,802).

McGuckin teaches all the claimed subject matter except for having a tine that projects in substantial alignment with the longitudinal axis. Imran teaches an array of tines as claimed, which is particularly similar to McGuckin, except that McGuckin does not have a tine that projects directly along the longitudinal axis. It would have been obvious to form the device of McGuckin with varying configurations of tines, including that of Imran, for optimizing the injections into target tissue sites, the longitudinally aligned tine for injections directly distal to the device.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin in view of Behl as applied to claim 4 above, and further in view of Foster (US 6,217,559).

McGuckin as modified by Behl teaches all the claimed subject matter except for a detent retaining member. Foster teaches this well-known engineering component at the end of tracks. It would have been obvious to one of ordinary skill in the art to provide such a retaining member on the device of McGuckin as modified by Behl, in order to maintain the tines in a deployed position, and appropriately release them when the operation is completed.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin in view of Imran (US 6,425,887) and Desai (US 6,231,591).

McGuckin teaches all the claimed subject matter except for having a tine that comes out in substantial axial alignment with the longitudinal axis of the outer tube and the tine(s) having a side port recessed from the distal tip. Imran teaches a substantially similar device that does have such a straight tine. It would have been obvious to incorporate the straight tine of Imran on the device of McGuckin to enable treatment of the area immediately distal to the end of the device as part of the target treatment area.

Desai teaches tines with side ports recessed from the distal tip. This kind of port is well known in the art for purposes of keeping the port from getting plugged with tissue when it is plunged into the injection site. It would have been obvious to one of ordinary skill in the art to use such a port configuration on McGuckin for the same reason.

Claims 10, 20, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin in view of Jones et al (US 5,849,011).

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McGuckin teaches all the claimed subject matter except for the release mechanism. Jones teaches a device with a release mechanism to allow cleaning and reuse of some of the components. (col. 33, lines 47-67; col. 42, lines 44-47). It would have been obvious to one of ordinary skill in the art to include the release mechanism of Jones on the device of McGuckin in order to permit cleaning and reuse of the components.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin and Jones as applied to claim 20, and further in view of Horzewski et al (US 5,873,865).

McGuckin as modified by Jones teaches all the claimed subject matter except a collagen plug deployer to be placed in the elongate member when the tines have been removed. However, McGuckin does teach that other surgical devices can be inserted through the outer tube. (col. 5, lines 17-19) Horzewski teaches that it is known to form TMR channels and fill them with collagen (col. 2, lines 5-9). In view of McGuckin's teaching of other devices for use through the lumen, and Horzewski's teaching of collagen plugs in ablation-formed channels, it would have been obvious to include a collagen plug deployer with the device of McGuckin, an ablation device, to establish such collagen-filled TMR channels.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin and Jones as applied to claim 20, and further in view of Foster.

See discussion of Foster above.

Allowable Subject Matter

Claims 11-16 and 19 are allowable over the prior art of record..

Claims 28-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art does not teach a tine deployment device, wherein the tines are deployable to two different positions, and that the actuator is moved in different directions for each deployable position or where the actuator is movable to the second position without moving to the first position. This claim language is evidently aimed at excluding devices as prior art that merely have two stages of deployment, where the actuator is simply pushed further out to reach a further deployed position. It has successfully done so.

The prior art does not teach the multiple retention members being located radially spaced from one another. The retention members of McGuckin are in a ratchet mechanism which is not typically a radially spaced configuration.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. In accordance with the interview summary of 25 September

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2003, this action is being made non-final, due to the improperly rendered, previous rejection of claims 20-23.

Conclusion

In accordance with the interview summary of 25 September 2003, this action is being made **NON-FINAL**, due to the improperly rendered, previous rejection of claims 20-23.


Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy T. Thissell whose telephone number is (703) 305-5261. The examiner can normally be reached on 8:30-7:00 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached at (703) 308-3552. The fax phone numbers for all fax communications is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

jt
February 5, 2004


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